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Filing date: **04/13/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Google Inc.		
Entity	Corporation	Citizenship	Delaware
Address	1600 Amphitheatre Parkway Mountain View, CA 94043 UNITED STATES		

Attorney information	Brendan J. Hughes COOLEY LLP 1299 PENNSYLVANIA AVENUE NW, SUITE 700 Washington, DC 20004 UNITED STATES trademarks@cooley.com, bhughes@cooley.com, jcullum@cooley.com, rgf@cooley.com Phone:202-842-7800
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Registration Subject to Cancellation

Registration No	3948486	Registration date	04/19/2011
Registrant	SPY PHONE LABS LLC 1465 ROUTE 23 SOUTH WAYNE, NJ 07470 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2010/09/01 First Use In Commerce: 2010/09/01 All goods and services in the class are cancelled, namely: Computer application software for mobile phones
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Grounds for Cancellation

The mark is or has become generic	Trademark Act section 2(e)(1), or section 23 if on Supplemental Register
The mark is merely descriptive	Trademark Act section 2(e)(1)
Other	(1) The application underlying the subject registration was void ab initio and/or the submitted statement of use was invalid; (2) non-ownership due to invalid assignment

Attachments	Petition to Cancel_SPY PHONE.pdf(45704 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Brendan J. Hughes/
Name	Brendan J. Hughes
Date	04/13/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration No. 3,948,486
For the Trademark SPY PHONE
Issued April 19, 2011

GOOGLE INC.,)	
)	
Petitioner,)	
)	Cancellation No.
v.)	
)	
SPY PHONE LABS LLC,)	
)	
Registrant.)	
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PETITION TO CANCEL

Petitioner Google Inc. (“Google”), a Delaware corporation having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California, 94043, believes that it is being damaged and will continue to be damaged by the registration of the SPY PHONE mark (Registration No. 3,948,486) (the “Subject Registration”) owned by Spy Phone Labs LLC (“Registrant”), a company with a listed address of 1465 Route 23 South #139, Wayne, New Jersey, 07470. Google hereby petitions to cancel the Subject Registration under Sections 1, 2(e)(1), and 10(a) of the Trademark Act of 1947, 15 U.S.C. §§ 1051, 1052(e)(1), and 1060(a). As grounds for cancellation, Google alleges the following:

The Subject Registration

1. On July 9, 2009, Internet Source Communications LLC (“ISC”) applied to register the SPY PHONE mark in connection with “Computer application software for mobile phones” with the U.S. Patent and Trademark Office (“PTO”) on an intent-to-use basis.

2. On April 19, 2010, ISC agreed to disclaim the exclusive right to use the term “PHONE” apart from the mark as shown. The PTO subsequently entered an appropriate disclaimer.

3. On February 3, 2011, ISC submitted a Statement of Use to the PTO, as well as an alleged specimen of use in the form of the computer-generated image below.



4. On information and belief, the software reflected in the specimen constituted spyware for a phone, and was offered through the domain spyphone.com. In addition, on information and belief, the specimen was not an actual image of product packaging.

5. On April 19, 2011, the PTO issued ISC a federal registration for the SPY PHONE mark.

Ownership and Assignment of the Subject Registration and the SPY PHONE Mark

6. On information and belief, ISC was not actually incorporated until May 7, 2012, over a year after the issuance of the Subject Registration.

7. On information and belief, the domain spyphone.com was registered to the entity Whitehouse.com Inc. until at least 2007, after which it was registered to White House Communications Inc.

8. On information and belief, the domain spyphone.com was registered to White House Communications Inc. until at least 2012, after which it was registered to Registrant.

9. On information and belief, ISC did not own the spyphone.com domain through which the SPY PHONE software was offered at the time the application underlying the Subject Registration was filed or throughout the prosecution of such application.

10. On information and belief, ISC has never used the SPY PHONE mark in connection with the software offered through the website at www.spyphone.com.

11. On information and belief, Registrant, not ISC, used the SPY PHONE mark in connection with Registrant's App (as defined below).

12. As detailed below, on October 22, 2014, Registrant filed a complaint against Google asserting contributory infringement of the trademark identified in the Subject Registration.

13. Eight days after filing suit against Google, on October 31, 2014, Registrant recorded an assignment with the PTO which purported to transfer the Subject Registration and all goodwill in the SPY PHONE mark from ISC to Registrant.

14. Registrant's *nunc pro tunc* assignment agreement stated that the alleged assignment had actually occurred over two years before "pursuant to an unwritten agreement between [ISC] and [Registrant] made on or around August 1, 2012."

15. As described in more detail below, Registrant has relied on such purported ownership of the registered SPY PHONE mark since in or around August 2012 in connection with trademark disputes with third-party developers of mobile application software ("apps") and Google, causing damage to such third parties and to Google.

Google's Google Play Service and Registrant's Spy Phone Mobile Application

16. Google is the owner of the Google Play service, an online platform for the distribution of apps and other media for mobile devices that use Google's Android operating system. The Google Play service functions as a marketplace for app developers to distribute their apps and for users to search for, review, and download them.

17. In or around August 2012, Registrant began offering an app under the name "SPY PHONE® Phone Tracker" through the Google Play service ("Registrant's App" or the "App").

18. On information and belief, Registrant's App allowed users to obtain information about the usage of a phone on which it was installed, including the location of the phone, the identities of senders and recipients of ingoing and outgoing communications, and Internet usage. Users of Registrant's App could review the information collected by the App in the users' respective accounts at www.spyphone.com.

Registrant's Dispute with Google

19. After Registrant began offering Registrant's App through the Google Play service, Registrant submitted multiple complaints to Google that other app developers were

distributing apps through the Google Play service under names that infringed Registrant's registered SPY PHONE mark.

20. Based on Registrant's representations that it owned the mark represented in the Subject Registration, and in accordance with Google's developer agreement and other applicable policies, Google suspended certain apps Registrant claimed were infringing its rights.

21. On or around October 22, 2014, Registrant filed a complaint against Google and unidentified app developers in the U.S. District Court for the District of New Jersey. Registrant asserted claims against Google for contributory trademark infringement and tortious interference. Registrant alleged, among other things, that Google contributed to the unidentified defendants' infringement of Registrant's SPY PHONE mark by distributing apps under infringing names.

22. On the basis of such claims, Registrant asked the Court for preliminary and permanent injunctions against Google, as well as "all other remedies available under the Lanham Act including but not limited to statutory damages, compensatory damages, treble damages, disgorgement of profits, costs and attorneys' fees."

23. On December 15, 2014, Google moved to dismiss Registrant's claims, and in the alternative to transfer Registrant's case to the Northern District of California.

24. On August 13, 2015, the U.S. District Court for the District of New Jersey ordered the transfer of the case to the Northern District of California.

25. Google renewed its motion to dismiss following the transfer to the Northern District of California. The Court granted Google's motion on March 21, 2016. It dismissed Registrant's infringement claim against Google on the basis that Registrant had not adequately alleged that Google had notice of the specific acts of infringement allegedly committed by the developer defendants. Registrant's claims were dismissed with leave to amend.

26. On April 11, 2016, Registrant filed its Second Amended Complaint. Registrant restated its claims against Google for contributory infringement and tortious interference and asserted a new claim under California's Unfair Competition Law, Cal. Bus. And Prof. Code §§ 17200 *et seq.*

**FIRST GROUND FOR CANCELLATION
THE SPY PHONE MARK IS GENERIC OR AT LEAST MERELY DESCRIPTIVE**

27. Google incorporates by reference paragraphs 1 through 26, inclusive, as if fully set forth here.

28. On information and belief, relevant consumers understand the term "SPY PHONE" to mean software that collects and reports usage information about a phone on which it is installed.

29. On information and belief, the products with which the SPY PHONE mark has been and is currently used are software that collects and reports usage information about a phone on which it is installed.

30. On information and belief, third parties use the component terms "SPY" and "PHONE" and variations thereof in connection with software that collects and reports usage information about a phone on which it is installed.

31. The term "SPY PHONE" is understood by relevant consumers as referring to the category of software Registrant offers and is thus a generic term for such software.

32. In the alternative, the term "SPY PHONE" conveys to relevant consumers an immediate idea of an ingredient, quality, characteristic, feature, function, purpose, or use of the software identified in the Subject Registration and is thus merely descriptive of such software. On information and belief, the term "SPY PHONE" has not acquired distinctiveness among relevant consumers.

33. Registrant's registration for the SPY PHONE mark provides *prima facie* evidence of the validity and ownership of this generic or at least merely descriptive term and of Registrant's exclusive right to use the term. Registrant's registration therefore interferes with the rights of others, including other developers on the Google Play service, to categorize or describe their apps.

34. Registrant has relied on its registration for the SPY PHONE mark to sue Google for contributory trademark infringement and to request the remedies available under the Lanham Act to the owner of a federally-registered mark. On April 11, Registrant filed a Second Amended Complaint against Google, which is currently pending. Further, Registrant has relied on its registration for the SPY PHONE mark to urge Google to take down apps offered by other developers, thereby interfering with Google's relationships with such developers. Google has therefore been damaged and will continue to be damaged by the registration of the SPY PHONE mark.

SECOND GROUND FOR CANCELLATION
THE APPLICATION UNDERLYING THE SUBJECT REGISTRATION WAS VOID AB INITIO AND/OR
THE SUBMITTED STATEMENT OF USE WAS INVALID

35. Google incorporates by reference paragraphs 1 through 34, inclusive, as if fully set forth here.

36. On information and belief, the corporate entity ISC was not in existence at the time that ISC purported to file the application underlying the Subject Registration, nor was it in existence at the time that it submitted the Statement of Use in connection with such application.

37. On information and belief, White House Communications, Inc. or Whitehouse.com Inc., not ISC, was using or intended to use the SPY PHONE mark at all times relevant to the issuance of the Subject Registration.

38. On information and belief, ISC could not have possessed and did not possess a *bona fide* intent to use the SPY PHONE mark in U.S. commerce at the time the application underlying the Subject Registration was filed. Therefore, the application underlying the Subject Registration was *void ab initio* under 15 U.S.C. § 1051 because it was filed by someone other than the owner of the mark.

39. On information and belief, the Statement of Use filed by ISC was invalid because ISC was not using the SPY PHONE mark in commerce at the time that it filed the Statement of Use, as demonstrated by the fact that (i) ISC had not yet been incorporated, and (ii) White House Communications Inc., not ISC, owned the domain spyphone.com (*i.e.*, the domain through which the SPY PHONE service was offered) at that time. The issuance of the Subject Registration thus violated 15 U.S.C. § 1051(b),(d).

40. Either because the application underlying the Subject Registration was *void ab initio* at the time of filing, or because the Statement of Use that enabled the underlying application to mature to registration was invalid, the Subject Registration should be cancelled as violating 15 U.S.C. § 1051.

**THIRD GROUND FOR CANCELLATION
NON-OWNERSHIP DUE TO INVALID ASSIGNMENT**

41. Google incorporates by reference paragraphs 1 through 40, inclusive, as if fully set forth here.

42. On information and belief, ISC never used the SPY PHONE mark in U.S. commerce, and therefore never owned the goodwill associated with the mark as of August 1, 2012 or any other date.

43. On information and belief, because ISC did not own the goodwill associated with the SPY PHONE mark at the time ISC purported to assign the mark to Registrant, such goodwill

was not in fact assigned to Registrant along with the Subject Registration. Therefore, the assignment of the Subject Registration from ISC to Registrant was invalid and thus did not affect a transfer of rights pursuant to 15 U.S.C. § 1060(a).

44. Because ISC did not transfer the goodwill associated with the SPY PHONE mark to Registrant, Registrant does not own the mark reflected in the Subject Registration and such Registration should be cancelled.

Wherefore, for the foregoing reasons, Google prays that the Petition to Cancel be sustained, and that Registration No. 3,948,486 be cancelled.

Respectfully submitted,

Date: April 13, 2016

By: /Brendan J. Hughes/
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Counsel for Petitioner Google Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **PETITION TO CANCEL** has been served on Registrant by mailing said copy on April 13, 2016 via First Class Mail, postage prepaid, to Registrant at the following two addresses of record with the PTO:

Internet Source Communications, LLC
1465 Route 23 # 139
Wayne, New Jersey 07470

Spy Phone Labs LLC
1465 Route 23 South # 139
Wayne, New Jersey 07470

Courtesy copies of the **PETITION TO CANCEL** were sent via email to the following counsel of record for Registrant in the federal litigation:

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Date: April 13, 2016

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